FILE COPY

Office - Supreme Court, U. S.
FILED
DEC 19 1946
CHARLES ELMORE CROPLEY
CLERK

Supreme Court of the United States

October Term, 1946

No. 704 740

THE FOXBORO COMPANY,

Petitioner,

vs.

TAYLOR INSTRUMENT COMPANIES,

Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

DRURY W. COOPER,
D. CLYDE JONES,
DRURY W. COOPER, JR.,
Counsel for Respondent.

INDEX

PAGE

1. Petitioner's First Point 2

2. Petitioner's Second Point 5

3. Petitioner's Third Point 8

4. Petitioner's Fourth Point 10

RESPONDENT'S POINTS 11

5. The Mason Patent is Void for not Disclaiming All that Should have been Disclaimed 11

6. Indefiniteness of Claims 16

CONCLUSION 20

Table of Cases

Bellavance v. Frank Morrow Co., 140 F. 2d 419, at pp. 422-3 (C. C. A. 1) certiorari denied, 322 U. S. 472 ... 4

Brooks et al. v. Fiske, 15 How. (56 U. S.) 212 18

Ensten v. Simon, Asher & Co., 282 U. S. 445, 453 16

General Electric Co. v. Wabash Electric Co., 304 U. S. 364 19

Haliburton Oilwell Cementing Co. v. Walker, decided November 18, 1946 .....18, 19

Hanovia Chemical & Mfg. Co. v. David Buttrick Co., 127 F. 2d 888 (C. C. A. 1) 7

Heald v. Rice, 104 U. S. 737, 749 6

Himmil Bros. Co. v. Serrick Corporation, 122 F. 2d 740 (C. C. A. 7) 7

PAGE

TABLE OF CASES *(Continued)*

Kuhn v. Princess, etc., 119 F. 2d 704 (C. C. A. 3) 7

Marconi Wireless Telegraph Company of America v. United States, 320 U. S. 1 .....11, 13, 15

Maytag Co. v. Hurley Co., 307 U. S. 243 14

McClain v. Ortmayer, 141 U. S. 419 9

Murray v. Noblesville Milling Co., 131 F. 2d 470 (C. C. A. 7) 7

Paquette et al. v. Potter Mfg. Co., 46 F. 2d 271, 272 (C. C. A. 6) 14

Picard v. United Aircraft Corporation, 128 F. 2d 632, 636 (C. C. A. 2), certiorari denied 317 U. S. 651 4

Potts v. Creager, 155 U. S. 597 6

Sinclair & Carroll Co. Inc. v. Interchemical Corp., 325 U. S. 327, 330 .....4, 7

Singer v. Cramer, 192 U. S. 265, 275 6

State Farm Mutual Automobile Insurance Co. v. Bonnaci, 111 F. 2d 412, 415 (C. C. A. 8) 7

Smyth Mfg. Co. v. Sheridan et al., 149 Fed. 208, 211 (C. C. A. 2) 13

United Carbon Co. v. Binney, 317 U. S. 228 18

U. S. Gypsum Co. v. Consolidated Co., 130 F. 2d 888, 892 (C. C. A. 6), certiorari denied, 317 U. S. 698 4

United States v. Esnault-Pelterie, 303 U. S. 26, 30 6

Statutes and Rules

Federal Rules of Civil Procedure, Rule 52 5

R. S. Sec. 4888 (35 U. S. C. A. Sec. 33) 18

Supreme Court of the United States

October Term, 1946

No. 704

THE FOXBORO COMPANY,

Petitioner,

vs.

TAYLOR INSTRUMENT COMPANIES,

Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

The petition for writ of certiorari and supporting brief nowhere describe the patent in suit, or the supposed invention that it contains; much less does either discuss the prior art which the Court of Appeals found to leave no room for invention in the claims in issue; but, by purely abstract statements seek to show that that Court made a decision that should be reviewed by this Court. No effort is made to analyze the huge record that is tendered.

The decision below is reported, 157 F. 2d 226.

The petition and supporting brief set forth four alleged reasons for the allowance of the writ which will be discussed seriatim herein. It will be shown that no reason for allowance exists and that, therefore, the petition should be denied.

1. Petitioner's First Point.

The first reason (Pet. 2-3) sets forth that there is a conflict between the decision in the instant case by the Court of Appeals for the Second Circuit and those of the First, and other circuits, because the Second Circuit Court "based its decision on an erroneous assumption that the Supreme Court in recent decisions has revolutionized the law determining the boundary between invention and skillful application".

We shall not attempt to refute this alleged conflict between the circuits because the Court of Appeals for the Second Circuit, in this case, did not rest its decision on "the change in recent years in the standard of invention adopted by the Supreme Court" as urged by petitioner (Pet. 2, last two lines). While the Court, in the last paragraph of its opinion, did make the statements quoted on the last three lines of page 2 and top of page 3 of the petition, yet it should be noted that it began that paragraph with these words (R. 1558): "Finally, when all else is said, we cannot ignore the change in recent years * * *". This shows clearly that it was an added reason and not the main reliance for the holding of invalidity.

Prior to that last paragraph the court had set forth cogent reasons for that holding having nothing to do with the so-called change in the test of invention by the Supreme Court. The Court actually held the patent in suit invalid because, while there were some differences in its disclosure over the prior art, yet those points of distinction *were not included in the claims* which themselves were not distinguishable over the prior art. This is shown by the follow-

ing quotation from the opinion of the Court of Appeals (R. 1555-6):

> "That there are differences between the disclosures of these three prior patents and Mason's is true, but these are irrelevant except in so far as they appear in Mason's claims, and *they do not appear there, except the element of an 'elastic fluid' in all but the first three; and Wünsch disclosed 'air' or a 'gas' as an alternative to 'oil'.** We should have no warrant for limiting the claims by the elements of the disclosure which they do not include, even if the elements were new. A patentee who claims broadly must prove broadly; he may not claim broadly, and recede as he later finds that the art unknown to him has limited his invention. That is the chance he must take in making broad claims; if he has claimed more than he was entitled to, the statute does give him a locus poenitentiae, but he must seasonably disclaim the broad claims in toto. He may not keep them by interpretative limitation; he must procure new claims by reissue. This is the significance of *Milcor Steel Co.* v. *George A. Fuller Co.*, 316 U. S. 143. This applies with exceptional force to the case at bar, in which Mason not only had his day in the Patent Office, but *twice thereafter amended his claims; first, by his disclaimer, next, by reissue.* It is true that Mason's single figure discloses no 'needle valve' in the pipe, '43', and the flapper, '35', as free from any opposing force, yet from start to finish neither the claims nor the specifications so much as intimate that either of these features was an element of the invention. It would be enough to prevent such an interpretation of the claims that, after so many efforts the claims remained silent upon these details, even if the specifications had mentioned them; but the interpretation becomes doubly impossible when we remember that no invention can be saved by features which appear only in the figures, and are not men-

* Emphasis supplied unless otherwise noted.

tioned in the text. *Permutit Co.* v. *Graver Corp.*, 284 U. S. 52, 60; *Vickery* v. *Barnhart*, 118 Fed. (2) 578, 585 (C. C. P. A.)." * * *

> *"For these reasons, merely as a matter of interpretation, we could not properly save the claims by incorporating into them those elements upon which the plaintiff relies to distinguish from the prior art; and even if we could, it would not save them."*

Thus it appears that the last paragraph of the opinion, upon which petitioner bottoms its first point, is nothing more than another reason for the reversal, philosophically discussed.

Cases in which statements by the Courts of Appeals similar to that here relied upon, have been made the basis of application for review by this Court and denied, are

Picard v. *United Aircraft Corp.*, 128 F. 2d 632, 636 (C. C. A. 2), certiorari denied 317 U. S., at page 651;

Bellavance v. *Frank Morrow Co.*, 140 F. 2d 419, at pp. 422-3 (C. C. A. 1), certiorari denied, 322 U. S. 472;

U. S. Gypsum Co. v. *Consolidated Co.*, 130 F. 2d 888, 892 (C. C. A. 6), certiorari denied, 317 U. S. 698.

On page 14 of its brief, petitioner cites *Sinclair & Carroll Co. Inc.* v. *Interchemical Corp.*, 325 U. S. 327, 330 in support of the principle that invention should be only more than the "mere exercise of the skill of the calling." In that case this Court independently construed the prior patents and patent in suit, just as the Court of Appeals did in the instant case. In the *Sinclair* case, the District Court held the patent invalid and not infringed. The Court of Appeals reversed both holdings, and this Court reversed the

Court of Appeals and held the patent invalid. It is interesting to note that this Court did not refer to the findings of the District Court and did not apply the principles of Rule 52 of the Federal Rules of Civil Procedure—for the obvious reason that the patent and the prior art were conceded facts which the Court could see for itself left no room for invention. This topic is discussed under the next heading.

2. Petitioner's Second Point.

The second point which petitioner raises is that the Court of Appeals "has substituted its judgment, not of law but of pure fact on the question of invention (citing cases), for that based upon the oral *evidence* * * * heard and believed by the judge of the District Court who decided this question of fact on the evidence in the case" (Pet. 3). Such reversal is asserted to be in conflict with many opinions of this and lower courts. This is argued at pages 14-15 of the supporting brief under the title "The error in reversing a finding of fact of the District Court based on ample supporting oral evidence".

Petitioner is in error in taking this position for the Circuit Court of Appeals did not substitute its judgment on a question of fact based on oral evidence for that of the Court below. As appears from the opinion of the Court of Appeals, its reversal is based on documents in the case, namely what the prior art patents and patent in suit clearly disclose. This is apparent from the discussion of what is clearly apparent on the faces of the Mason patent in suit (R. 1545) the prior Lindsay (R. 1548-50), Wingfield (R.

1550-2), and Wünsch (R. 1552-5) patents, leading to the conclusion:

> "That there are differences between the disclosures of these three prior patents and Mason's [the patent in suit] is true, but these are irrelevant except in so far as they appear in Mason's claims, and they do not appear there, except the element of an 'elastic fluid'* in all but the first three; and Wünsch disclosed 'air' or a 'gas' as an alternative to 'oil' * **" (R. 1555).

The Court of Appeals correctly went to the disclosure of the patent in suit and those of the prior patents, and made its own comparison to decide whether the patentee's structure was to be classified as a patentable invention or whether it was not. *Potts* v. *Creager,* 155 U. S. 597; *Heald* v. *Rice,* 104 U. S. 737, 749; *Singer* v. *Cramer,* 192 U. S. 265, 275; *United States* v. *Esnault-Pelterie,* 303 U. S. 26, 30. These authorities establish that not only when there is no substantial dispute either as to the devices of the prior art or as to what the patentee did, but also when the prior art and what the patentee did is clearly apparent to the appellate court from the record and exhibits, then it is for that Court to compare the alleged invention with the prior art and from that comparison to say whether the patentee's structure is to be classified as a patentable invention over

---

* The idea of "elastic fluid" did not come into the claims until the filing on May 11, 1933 of disclaimer with respect to the original of the reissue patent in suit (Defdt.'s App. 399). This was two years and eight months after the filing of the Mason application on September 15, 1930 (Defdt.'s App. 296) and three months after the granting of the original Mason patent.

** The specification of the Mason patent in suit merely calls for "Fluid under pressure, such as compressed air * * *" (Defdt.'s App. 296, col. 1, lines 41-2) and the claims as originally issued cover *any* pressure whether oil, water or air (Defdt.'s App. 396).

the prior art or whether it is not. See *Hanovia Chemical & Mfg. Co.* v. *David Buttrick Co.*, 127 F. 2d 888 (C. C. A. 1). This is what this Court did in *Sinclair & Carroll Co. Inc.* v. *Interchemical Corp.*, 325 U. S. 327 (*supra*).

This rule applies all the more strongly in the instant case because the trial court made no true finding of fact below with respect to the prior art. It made only a general *conclusion* with respect to invention over the prior patents. The only place in the findings where the District Court dealt with the prior art patents, upon which the Court of Appeals based its reversal, is in the following finding:

> "58. The defendant cited and introduced evidence relating to the following prior art patents, publications and devices: Wingfield Br. Patent No. 254,469, Lindsay Br. Patent No. 218,370, Lindsay Br. Patent No. 234,194, Smoot 1,680,750, Wünsch 1,959,889, Frymoyer, 1,799,131, Mason 1,950,989, Trinks' Book, Hygrostat, Taylor Type P Controller, Taylor Type D Controller, Smoot Controller, Taylor Type 3R Controller, Taylor Type 27R Controller. None of them anticipates the inventions of Mason as disclosed in the patent. The inventions of Mason constitute patentable improvement and invention over the subject matter of all of the prior patents, publications or devices herein referred to." (Defdt.'s App. 689)

The above quoted conclusion falls into that category where the appellate courts are not bound by Rule 52 of the Federal Rules of Civil Procedure, but are free to decide themselves. *Himmil Bros. Co.* v. *Serrick Corporation*, 122 F. 2d 740 (C. C. A. 7); *Murray* v. *Noblesville Milling Co.*, 131 F. 2d 470 (C. C. A. 7); *Kuhn* v. *Princess, etc.*, 119 F. 2d 704 (C. C. A. 3); *State Farm Mutual Automobile Insurance Co.* v. *Bonacci*, 111 F. 2d 412, 415 (C. C. A. 8).

At the very end of its opinion, the Court below adverted to the plaintiff's mode of trying the case—which apparently had befuddled the trial Court—by saying "once the cloud of complicated scientific theory, with which it [*i.e.*, the patent] has been surrounded, is blown away, and the issues are bared as they really are, we have no doubt" (R. 1558) of its disposition.

Therefore we say the Court of Appeals was fully justified in the course it took to relieve the public of the incubus of an invalid patent.

3. Petitioner's Third Point.

Petitioner's third point is that the Court below, in its decision, rejects "the industry's acceptance of these machines as any evidence whatever that Mason's claims were valid" (Pet. 3). This statement was made by the Court of Appeals, but petitioner has lifted it out of its context thereby changing its meaning, and from that argues that the success "was directly attributable to the novel combination claimed" (Pet 16).

The Court, after a general discussion of success, mentioned factors other than novelty and value of the disclosure which might account for success. It then said (R. 1557):

> "In the case at bar let us, nevertheless, eliminate all such possible factors; let us suppose that it was only the differences between the disclosure of Mason and those of Lindsay, Wingfield and Wünsch, which for the first time made possible a machine acceptable to the art. We should still be as far as ever from any safe use of this evidence, for the *question is of the success to be attributed to that part of the disclosure which the claims have selected.*[1] Only in case we have

[1] See the discussion of petitioner's assertion with reference to success as related to the combination claimed, at page 19 hereof.

> some assurance that the success was here due to those factors by which the *claims differed from the prior art,* ought we take it as a criterion; and it would certainly be a gratuitous assumption to suppose that the industry's acceptance of these machines was due in any measure to those factors in the claims if indeed there are any. We therefore reject the industry's acceptance of these machines as any evidence whatever that Mason's claims were valid; and, being thrown back upon any advance over the art discoverable in them, we are at a loss to find any unless it be the gathering of factors which had all appeared before. When that occurs by a gathering from remote arts, it is often an index of much insight and perspicacity; but not when the combination is of factors to be found in the very field, and especially in so special a field as this; and certainly not when the tempo has been so swift as it was here" (R. 1557-8).

In the first place, commercial success can only be considered as supporting invention when doubt exists (*McClain* v. *Ortmayer,* 141 U. S. 419). The Court of Appeals neither expressed nor inferred doubt of validity.

In the second place, the Court of Appeals held that none of the differences of the Mason patent over the prior art appeared in the claims in suit (R. 1555). Thus, in the portion of its opinion last quoted, no success could be attributed to any differences over the prior art, which immediately brought the Court to considering the success as attributable to "the gathering of factors which had all appeared before" (R. 1557, bottom). Directly after this, the Court said (R. 1557, foot):

> "When that occurs by a gathering from remote arts, it is often an index of much insight and perspicacity; but not when the combination is of factors to be found in the very field, and especially in so special field as this; and certainly not when the tempo has been so swift as it was here."

It is because of this, and because there was no doubt of invalidity, that the Court of Appeals rejected any evidence of success to support validity, and in this it was upon absolutely sound ground—long since settled as indicated by the *McClain* case just cited.

We submit that this point does not stand analysis, and should be rejected.

4. Petitioner's Fourth Point.

The fourth point which petitioner attempts to make in support of its petition is that the Court of Appeals "has decided as a fact that in this art 'the tempo has been * * * swift' " and argues that "The decision conflicts with the oral testimony of the witnesses seen, heard and believed by the judge of the District Court who decided this question of fact on this evidence, as to which there was no conflict" (Pet. 4—argued pp. 17-8).

There was nothing to prevent the Court of Appeals from so holding in view of the undisputed facts that the prior patents to Lindsay, in 1925, Wingfield, in 1926 and Wünsch, in 1929—upon which it relied (R. 1548-52)—were quickly followed by the application for the patent in suit in 1930 (R. 1545). As that Court held "the law unsparingly charges him [the patentee of the patent in suit] with an acquaintance with all the earlier developments of the art" and that "his work is merely the latest refinement of a continuous progress, proceeding by trial and error" (R. 1557). The prior patents referred to were of course those which the Court of Appeals said contained the elements of the patentee's claims (R. 1555).

In addition, petitioner's point is wholly collateral since it makes no difference whether the tempo was swift or slow, because regardless of that the elements of the claims were all found in the three prior patents.

We submit that the point is wholly lacking in substance.

RESPONDENT'S POINTS

There are certain points not mentioned by petitioner which have a bearing upon the grant or denial of the petition.

5. The Mason Patent is Void for not Disclaiming All That Should Have Been Disclaimed.

This point was decided adversely to the defendant (respondent here) by the Court of Appeals, but *the Court did not consider the case in this Court controlling* on the facts, although it was pressed in the defendant's brief in the Court below. That is the case of *Marconi Wireless Telegraph Company of America* v. *United States*, 320 U. S. 1.

The facts at bar are these: The original patent was applied for September 15, 1930, and granted February 14, 1933 (Defdt.'s App. 296). On March 27, 1933, Frymoyer of plaintiff wrote to Swift of defendant charging infringement of the original of the patent in suit by its Fulscope-Dubl-Response Controller (Defdt.'s App. 324-5), which had been on the market since shortly before September 19, 1932 (Defdt.'s App. 33).

Swift immediately replied, March 30, 1933 (Defdt.'s App. 326) and advised Frymoyer of four prior patents

which negatived the novelty of the claims of the original patent. Frymoyer says he had never previously seen any of these prior patents (Pltff.'s App. 925) and the record shows that immediately recognizing their controlling importance he consulted with Miller, his patent attorney (Pltff.'s App. 926), and with the officers of his company. But he did not communicate with defendant.

After discussions with plaintiff's counsel of the cited prior patents (Exs. P-152-5, Defdt.'s App. 327-31), and as a result of them, a disclaimer was drawn up, signed and filed (Pltff.'s App. 926-7) May 11, 1933. Among other things there was disclaimed "*the subject matter" of* claim 3 of the original patent (Defdt.'s App. 399). That claim is identical with claim 4 of the original patent (claim 2 of the reissue in suit and relied on by petitioner, in the District Court as typical) except for the addition of the last four lines of claim 2 which are here printed in italics:

> "2. A fluid-pressure-operated control mechanism of the supply and waste valve type comprising a control couple, one element of which affords a port to atmosphere and the other a valve for said port, the relative approach and recession of said elements governing the pressure in the system, and means conjointly to control the relative position of said elements comprising a device responsive to the fluctuations of a variable condition which is affected by the controlled action, and a chamber subject to the controlled pressure having a part movable responsively thereto, *said chamber being adjustably movable as a whole and by such adjustment effecting movement and adjustment of one of said elements relative to the other*" (Defdt.'s App. 299, 396).

The drawing shows and the specification of the Mason patent (original, Defdt.'s App. 391—reissue, Defdt.'s App.

295) describes a *particular* way of securing adjustability of the nozzle relative to the flapper of the control couple, namely, "adjusting screw 49" (p. 1, col. 2, lines 36-7, Defdt.'s App. 296) so that the adjustment may be made *manually* for new conditions encountered. Without that mechanical feature adjustability is unobtainable in the Mason device. The adjustability is intended to set the mechanism to control at different selected temperatures just as the household thermostat can be set manually, for example, at 65, 70, 75 degrees. *It takes no part in the operation of the combination, but, once set, continues unchanged until manually readjusted* (Defdt.'s App. 296, Pat. p. 1, col. 2, lines 53-4).

The last clause of claim 4 of the original (claim 2 of reissue in suit) is merely a functional statement of *adjustability* and does not mention, indicate or describe *any element* by which that function is to be attained.

The fact that a part is made adjustable has never been considered by the courts as constituting a definite or *patentable distinction* over that which is old or even between claims themselves.

In *Marconi Wireless Telegraph Company of America* v. *United States,* 320 U. S. 1, 32, the Court said:

> "The variable inductance imparted no new function to the circuit; and merely making a known element of a known combination adjustable by a means of adjustment known to the art, when no new or unexpected result is obtained, is not invention." (Citing cases.)
>
> "Mere adjustability of parts does not constitute invention." *Smyth Mfg. Co.* v. *Sheridan et al.,* 149 Fed. 208, 211 (C. C. A. 2).

Since "the subject matter" of claim 3 was disclaimed, making that "subject matter" adjustable as in claim 2 of the reissue, did not make it patentable.

> "It involved adjustability only and adjustability is not invention." *Paquette et al.* v. *Potter Mfg. Co.*, 46 F. (2d) 271, 272 (C. C. A. 6).

Upon the above state of facts it is defendant's contention that Mason original patent is invalid for failure to disclaim indistinguishable subject matter, *i.e.* claim 4 of the original (claim 2 of the reissue in suit), when he disclaimed claim 3 of the original; and the reissue is invalid because claim 4, the claim of the original which should have been disclaimed, *came over into the reissue unchanged* as claim 2 in suit, and is still held *in terrorem* over the art. It was relied upon as "typical" by our adversaries, and was sustained in the District Court.

When plaintiff, upon notice from the defendant of certain prior patents, filed its disclaimer on May 11, 1933, giving up the entire subject matter of claim 3 and admitting through Mason that it was not his invention, it was in duty bound to disclaim the patentably indistinguishable claim 4 (claim 2 in suit) and failure to do so brings it under the rule of *Maytag Co.* v. *Hurley Co.*, 307 U. S. 243.

In that case claims 1 and 38 had been disclaimed by plaintiff after an adjudication of their invalidity. But the court held that another claim, 39, not in issue in the prior suit or there, was not patentably distinguishable from those which had been disclaimed. In holding the entire patent invalid for failure to disclaim claim 39, the Supreme Court said:

> "There has been unreasonable neglect or delay in entering a disclaimer of claim 39 within the meaning of R.S. 4917, and R.S. 4922, unless that claim is 'definitely distinguishable from the parts claimed without right',—that is, the disclaimed method claims 1 and 38. This must be so, for the company, by disclaiming those claims, has confessed that the patentee therein claimed 'more than that of which he was the original or first inventor or discoverer' and that the company, as assignee of the patent, therefore, 'did not choose to claim or to hold' the method therein disclosed 'by virtue of the patent or assignment.'" *Maytag Co.* v. *Hurley Co.*, 307 U. S. 243, 245.

The only distinction between the facts in the *Maytag* case and those at bar is that in the former a court had held the disclaimed claims to be invalid, while in the latter the disclaimer was the result of plaintiff's *being convinced by defendant's citation of prior patents* that claim 3 was invalid.

Petitioner, in the Court below, has attempted to distinguish the case at bar from the *Maytag* case on the ground that the disclaimer here was voluntary, but we submit that that is not a proper difference. In fact, it was due to the defendant's calling attention to prior patents.

Besides, the language of the *Maytag* case admits of no such distinction. But the point of asserted distinction was overruled by this Court in *Marconi Co.* v. *U. S.*, 320 U. S. 1, 58; which held that a voluntary disclaimer filed some years after the grant of the patent was too long delayed in view of patentee's knowledge of a certain prior patent, where there had been no decision sustaining that as a defense. In holding the patent invalid the court said:

> "The purpose of the rule that a patent is invalid in its entirety if any part of it be invalid is the pro-

> tection of the public from the threat of an invalid patent, and the purpose of the disclaimer statute is to enable the patentee to relieve himself from the consequences of making an invalid claim *if he is able to show both that the invalid claim was inadvertent and that the disclaimer was made without unreasonable neglect or delay.* * * * Here the patentee has sustained neither burden."

In the instant case the patentee did not merely let the invalid claim remain in the patent as in the *Marconi* case; he deliberately preserved it by *asserting it in the reissue* and in the Courts below as in the *Marconi* case, he "has sustained neither burden".

This is the case which the Court below failed to notice, although it was stressed in our brief to that Court.

We submit that the rule in the *Maytag* case is applicable whether the disclaimer was made as a result of a court holding of invalidity or whether voluntary.

Since

> "Delay begins whenever the patentee becomes aware that he has claimed more than he has invented or described." *Ensten* v. *Simon, Asher & Co.*, 282 U. S. 445, 453,

plaintiff's delay has continued for *more than 13 years, i.e.* since *May 11, 1933*, the date of the insufficient disclaimer, until the present time.

6. Indefiniteness of Claims

Petitioner asserts (Pet. p. 6) that "claims 10 and 13 are definite". We say, on the contrary, that petitioner in the Court below, brought in two unnamed elements, in order to distinguish the prior art: The indefiniteness of the claims,

10 and 13, which alone are pressed here, grows in part out of their use of the phrase "control mechanism of the supply and waste valve type". By the specification (Defdt.'s App. 296; patent in suit, col. 1, lines 36-41 and lines 50-55) this undoubtedly refers to the flapper 35 and nozzle 31. That this is true of the specification was asserted in our brief below and not denied. Yet in their brief below our adversaries (at page 14 and elsewhere) referred to a wholly different part—namely "control head 19", which they now call a "relay" valve—as controlling the supply and waste.

Again, neither claim mentions a spring as a part of the so-called motors—39, 53 of the drawings,—nor is it described in the specification. Yet it is asserted in our adversaries' brief below to be a substantive part of both the so-called "proportioning" controller (Pltff.'s Brief below, p. 15) and the so-called "reset" controller of the patent (claim 10 is on the proportioning controller; claim 13 on the reset). As to this element it was found by the trial court that *without it the operation described in the patent could not take place* (Defdt.'s App. 660).

It is these alterations in the claims that are parts of all the devices upon which petitioner relies for its proof of commercial acceptability. They give pertinence to the uncertainty of the claims; indeed, they make of them the traditional "nose of wax".

It should be understood that plaintiff relies on its petition for a review of the *entire* case. But there were pressed upon the court below *all the claims except No. 18*, and a mere perusal of them will show many that are so fulginous as to pass understanding. For example claims 11, 12, 13, 15 and 16 prescribe the "rate of change of condition"; but

what that is, is not set forth in the specification. In claims 19 to 24 means are set forth which are movable in accordance with a "predetermined asymptotic curve"; but that term is not in the specification, and Mason, the patentee, seems to admit that what is disclosed is *not* an asymptotic curve (Defdt.'s App. 656).

Claims 17 to 25 were not in the original patent but were added in the reissue [compare Defdt.'s App. p. 397 with pp. 311-2]. These added claims are, we submit, entirely indefinite. They substitute for distinct statements of the parts of a combination, recitals of "means" and of functions of such means in such involved language as to be practically non-understandable. For that reason they are all invalid under a long line of cases in this Court, from *Brooks et al.* v. *Fiske,* 15 How. (56 U. S.) 212, to *Haliburton Oilwell Cementing Co.* v. *Walker,* decided on November 18, 1946.

Mason was interrogated as to the meaning of the claims, including claim 25, which uses the word "means"—for doing this or that—13 times. He said he would not try to answer that question if the claim used the term but once (Defdt.'s App. 655). That is, the inventor himself had no understanding of the claims of his patent. How, then, could the public apprehend their meaning? Compare *United Carbon Co.* v. *Binney,* 317 U. S. 228, wherein as appears particularly at pages 233 *et seq.,* the patentee gave such interpretation to the claims as to make that which appeared to be definite so uncertain as to vitiate the patent.

All this seems to establish beyond cavil that R. S. Sec. 4888 (35 U. S. C. A. Sec. 33) requiring distinctness of claims, has not been complied with, and the patent is therefore invalid as to all its claims except No. 18 which is not in suit.

General Electric Co. v. *Wabash Electric Co.*, 304 U. S. 364;
Haliburton Oilwell Cementing Co. v. *Walker*, Decided by this Court Nov. 18, 1946.

At page 16 of the Petition, the top full paragraph gives an entirely erroneous impression of the evidence, since it introduces the statement by the sentence that "the success" [of the Mason device] "was directly attributable to *the novel combination claimed.*" The first three references to the record are to witnesses who, so far as appears, had no knowledge whatever of the patent in suit, made no reference to its claims, and were simply describing the utility of the petitioner's devices, which contained the improvements of scores of patents besides the one in issue. So with the series of references to Mason's testimony. He was dealing with the plaintiff's commercial devices, or else with the specification of the patent, or with a Bristol patent, or with one of defendant's instruments, at the pages cited. He made no reference whatever to the claims, and on cross-examination disclaimed all knowledge of them (Pltff.'s App. 655).

It is the fact that the trial Court found that both "proportioning" and "proportioning plus reset" controllers were old (finding 16, Defdt.'s App. 681) but that they were operated by a "*powerful*" measuring element; and (finding No. 17) that none was operable by a "*weak*" measuring element. But neither specification nor claims of Mason describes or is limited to weak or strong elements.

Petitioner is harping upon things not found in the claims; whereas the Court of Appeals compared the *claims* with the prior art, and on that basis found them invalid.

CONCLUSION

We submit that for the foregoing reasons the petition for writ of certiorari should be denied.

DRURY W. COOPER,
D. CLYDE JONES,
DRURY W. COOPER, JR.,
Counsel for Respondent.

(P—1676)